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Paper No. 32

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New York, NY 10022

**COPY MAILED**

**JUN 03 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Elazar Rabbani, et. al. :  
Application No. 08/978,632 :  
Filed: November 25, 1997 :  
Attorney Docket No. ENZ-53(C) :

**ON PETITION**

This is a decision on the petition under 37 CFR 1.137(b), filed August 20, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b)<sup>1</sup> must be accompanied by: (1) the required reply;<sup>2</sup> unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (1).

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action of May 20, 2002. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted with the instant petition does not *prima facie* place the application in condition for allowance, the reply

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<sup>1</sup> As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

<sup>2</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

required must be a Notice of Appeal (and appeal fee) or the filing of a continuing application.

37 CFR 1.137(c) requires a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted on the above-identified application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. Since the application is a utility or plant application filed after June 8, 1995, a terminal disclaimer is not required. Accordingly, the terminal disclaimer filed with the instant petition is unnecessary. Therefore, the fee of \$55 will be refunded to petitioner's deposit account.

The Office sincerely apologizes for the delay in responding to the instant petition; and any inconvenience caused to petitioner by this delay.

Further correspondence with respect to this matter should be addressed as follows:

**By Mail:** Mail Stop PETITION  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

**By Hand:** Customer Window  
2011 South Clark Place  
Crystal Plaza Two, Lobby  
Room 1B03  
Arlington, VA 22202

**Responses filed by Hand delivery on and after June 5, 2004, should be addressed as follows:**

**U.S. Patent and Trademark Office  
220 20th Street S.  
Customer Window, Mail Stop PETITION  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202**

**By Fax:** Attn: Office of Petitions  
(703) 872-9306

Telephone inquiries concerning this decision should be directed to the undersigned at (703)308-6711.



Andrea Smith  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

Enclosure: Advisory Action